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OFFICE OF PETITIONS

In re Application of : Decision on Petition for
Apple et al. : Patent Term Extension
Application No. 08/736,143 :
Filing Date: October 28, 1996 :
For: MEDIA WALL FOR DISPLAYING :
FINANCIAL INFORMATION :
:

The above-identified application has been forwarded to the undersigned for consideration on the "Petition For Patent Term Extension Pursuant To 37 CFR 1.181," which was received on September 2, 2005 requesting a patent term extension of 1,183 days. See 35 U.S.C. § 154(b)¹ and 37 C.F.R. § 1.701.

The petition under 37 CFR 1.182 and 37 CFR 1.181 is granted.

Petitioner notes that the Notice of Allowance dated June 9, 2005, in the above-identified application did not indicate a patent term extension. The above-identified application was filed on October 28, 1996 and a Notice of Appeal was filed on August 24, 2001. On November 18, 2004, the application was remanded to the examiner by a panel of the Board of Patent Appeals and Interferences after a remand from the Court of Appeals from the Federal Circuit. Petitioner argues that because the pendency will be greater than three years, there should be patent term extension under 35 U.S.C. 154 and 37 CFR 1.701. Petitioner argues that due to the successful appeal, there should be a patent term extension 1,183 days.

35 U.S.C. § 154(b) provides for patent term extension for appellate review, interference and secrecy order delays in applications filed on or after June 8, 1995 and before May 29, 2000, and, as amended by the "American Inventors Protection Act of 1999," enacted November 29, 1999, as part of Public Law 106-113, for those delays and others in applications filed on or after May 29, 2000.

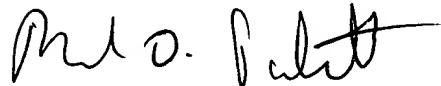
A Notice of Appeal was filed in the above-identified application on August 24, 2001; the Notice of Appeal was reinstated on June 7, 2002. On November 19, 2004, a panel of the Board of Patent Appeals

¹35 U.S.C. § 154 was amended by the "American Inventors Protection Act of 1999," which was enacted on November 29, 1999 as part of Public Law 106-113 (Consolidated Appropriations Act for Fiscal Year 2000). Since this amendment is effective May 29, 2000 and applies to applications filed on or after that date, the prior patent term adjustment provisions of 35 U.S.C. § 154 continue to apply to the above-identified application.

and Interferences (BPAI) remanded the application to the examiner in the above-identified application. Since the above-identified application was filed after June 7, 1995, there is no terminal disclaimer due to the issue of another patent claiming subject matter that is not patentably distinct from that under appellate review, and issuance of the application as a patent was delayed due to appellate review resulting in a remand by a panel of the BPAI to the Examiner, the patent to issue from the application is entitled to an extension of the patent term.² The period of delay in the above-identified application is the period beginning on August 24, 2001, the date that the Notice of Appeal was first filed and ending on November 19, 2004, the date of the remand by a panel of the BPAI, which is a final decision in favor of the applicant. Three years after the earliest effective filing date of the application is October 28, 1999. Accordingly, the period of extension is not required to be reduced pursuant to 37 CFR 1.701(d)(1) by the amount of time prior to three years after the filing date of the application. As a result, the period of extension is 1,184 days, the period from August 24, 2001 to November 19, 2004 including the beginning and end dates.

After mailing of this decision, the above-identified application will be forwarded to Office of Publications for further processing. The patent, if issued, will include an indication that the patent term is extended by **1,184 days**.

Telephone inquiries with regard to this communication should be directed to Mark O. Polutta at (571) 272-7709.



Mark O. Polutta
Senior Legal Advisor
Office of Patent Legal Administration
Office of the Deputy Commissioner
for Patent Examination Policy

²Revision of Patent Term Extension and Patent Term Adjustment Provisions, 78 FR 21704, 21705 (April 22, 2004), 1282 Off. Gaz. Pat. Office Notices 100 (May 18, 2004) (final rule).